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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/067,148 05/26/93 MONTAGNIER

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HM22/1010  
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EXAMINER

PARKIN, J

ART UNIT

PAPER NUMBER

1648

47

DATE MAILED:

10/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.

08/067,148

Applicant(s)

Montagnier et al.

Examiner

Jeffrey S. Parkin, Ph.D.

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on 06/03/98, 06/30/98, and 08/28/98.

2a) ☐ This action is **FINAL**.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 29-31 and 37-44 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 29-31 and 37-44 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other:

Serial No.: 08/067,148  
Applicants: Montagnier, L., et al.

Docket No.: 3495.0004-04  
Filing Date: 05/26/93

### Detailed Office Action

#### *Status of the Claims*

1. Acknowledgement is hereby made of receipt and entry of the communications filed 03 and 30 June, 1998, and 28 August, 1998. Applicants are reminded that claims 15, 16, and 18-20 were canceled in the response filed 03 June, 1998. Claims 29-31 and 37-44 are pending in the instant application.

#### *37 C.F.R. § 1.129(a)*

2. Since this application is eligible for the transitional procedure of 37 C.F.R. § 1.129(a), and the fee set forth in 37 C.F.R. § 1.17(r) has been timely paid, the finality of the previous Office action is hereby withdrawn pursuant to 37 C.F.R. § 1.129(a). Applicants' submissions filed on 03 and 30 June, 1998, and 28 August, 1998 have been entered.

#### *35 U.S.C. § 112, First Paragraph*

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 29-31 and 37-44 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. *In re Rasmussen*, 650 F.2d 1212, 211 U.S.P.Q. 323 (C.C.P.A. 1981). *In re Wertheim*, 541 F.2d 257, 191 U.S.P.Q. 90 (C.C.P.A. 1976). Claims 37-

44 are directed toward antibodies specific toward HIV-1 p12, p18, mixtures of antibodies specific for p12 and p25, mixtures of antibodies specific for p18 and p25, and mixtures of antibodies specific for p12, p15, p18, p25, p36, p42, and p80. Claims 29-31 are drawn toward immunological complexes comprising a purified HIV-1 antigen (e.g., p12 or p18) and specific antibody. Applicants traverse the rejection and submit that adequate support exists in the specification for the claimed invention. Applicants' arguments have been duly noted but are not deemed to be persuasive for the reasons of record previously set forth.

As previously noted, the written description requirement under Section 112, first paragraph, stipulates that the claimed subject matter must be supported by an adequate written description that is sufficient to enable anyone skilled in the art to make and use the invention. The courts have decided that the specification must demonstrate that the inventor had possession of the claimed invention as of the filing date relied upon. Although the claimed subject matter need not be described identically, nonetheless, the disclosure relied upon must convey to those skilled in the art that applicants had invented the subject matter claimed. *Ralston Purina Company v. Far-Mar-Co., Inc.*, 227 U.S.P.Q. 177 (C.A.F.C. 1985). *In re Wilder, et al.*, 222 U.S.P.Q. 369 (C.A.F.C. 1984). *In re Wertheim, et al.*, 191 U.S.P.Q. 90 (C.C.P.A. 1976). *In re Blaser, Germscheid, and Worms*, 194 U.S.P.Q. 122 (C.C.P.A. 1977). *In re Driscoll*, 195 U.S.P.Q. 434 (C.C.P.A. 1977). *Utter v. Hiraga*, 6 U.S.P.Q.2d 1709 (C.A.F.C. 1988).

This rejection is based upon the inability of the disclosure to reasonably convey to the skilled artisan that applicants were in possession of the claimed HIV-1 antibodies and immunological complexes at the time of the filing date relied upon. The specification fails to provide any demonstrative evidence that applicants had generated the claimed antibodies or immune complexes.

Moreover, the disclosure only refers to subject matter directed toward a newly isolated virus, the antigens p13, p18, and p25 (refer to disclosure, page 6). The disclosure describes the isolation, purification, and propagation of this virus, designated LAV by applicants. It was further reported that extracts containing p12, p18, and/or p25 were prepared. There was one mention of patient antibodies that displayed reactivity toward the LAV antigens p12, p18, p25, p36, p42, and p80 (refer to page 13 of the disclosure). However, there was no indication that applicants actually contemplated generating, isolating, and characterizing LAV-specific antibodies. Moreover, there is no indication that applicants actually contemplated making and/or using these antibodies or immune complexes comprising these antibodies and the appropriate viral antigen. Accordingly, the skilled artisan would reasonably conclude that applicants were not in possession of the claimed invention at the time of filing. Applicants may obviate the rejection by providing scientific evidence demonstrating that the claimed antibodies and immune complexes were actually generated.

#### ***Non-statutory Double Patenting***

5. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 U.S.P.Q. 644 (C.C.P.A. 1969); *In re Vogel*, 422 F.2d 438, 164 U.S.P.Q. 619 (C.C.P.A. 1970); *In re Van Ornum*, 686 F.2d 937, 214 U.S.P.Q. 761 (C.C.P.A. 1982); *In re Longi*, 759 F.2d 887, 225 U.S.P.Q. 645 (Fed. Cir. 1985); and *In re Goodman*, 29 U.S.P.Q.2d 2010 (Fed. Cir. 1993). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-

statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. § 3.73(b).

6. Claims 18-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6, 10-13, and 18-22 (refer to Appendix A) of U.S. Patent No. 5,135,864. The claims of the '864 patent disclose the HIV-1 antigens p15, p25, p36, p42, and p80. It would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to generate antibodies against these proteins to facilitate the detection of HIV-1. One of ordinary skill in the art would be motivated to use these antibodies either alone, or in combination, for diagnostic purposes.

7. Claims 37-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4, 5, 7, and 9-11 (refer to Appendix A) of U.S. Patent No. 5,217,861. The claims of the '861 patent disclose the HIV-1 antigens p12, p18, and p25. It would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to generate antibodies against these proteins to facilitate the detection of HIV-1. One of ordinary skill in the art would be motivated to use these antibodies either alone, or in combination, for diagnostic purposes.

#### Correspondence

8. Correspondence related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must

conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Official communications should be directed toward one of the following Group 1600 fax numbers: (703) 308-4242 or (703) 305-3014. Informal communications may be submitted directly to the Examiner through the following fax number: (703) 308-4426. Applicants are encouraged to notify the Examiner prior to the submission of such documents to facilitate their expeditious processing and entry.

9. Any inquiry concerning this communication should be directed to Jeffrey S. Parkin, Ph.D., whose telephone number is (703) 308-2227. The examiner can normally be reached Monday through Thursday from 8:30 AM to 6:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner are unsuccessful, the examiner's supervisors, James Housel or Laurie Scheiner, can be reached at (703) 308-4027 or (703) 308-1122, respectively. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196.

Respectfully,

Jeffrey S. Parkin, Ph.D.  
Patent Examiner  
Art Unit 1648

03 October, 2001